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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,203	02/23/2004	Dylan Van Atta	2242-67334	8831
24197 7590 10/19/2007 KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			EXAMINER MORAN, KATHERINE M	
			ART UNIT 3765	PAPER NUMBER
			MAIL DATE 10/19/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/785,203

Applicant(s)

ATTA ET AL.

Examiner

Katherine Moran

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-19,33-39,44-47 and 54-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18,19,36 and 39 is/are allowed.
- 6) ☒ Claim(s) 13-17,33-35,37,38,44-47 and 54-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/3/07.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's response of 7/3/07 has been received. The response amended claims 13, 16-19, 33, 36, 37, 39, 44, 54, and 55 and included new claims 59-67. Claims 13-19, 33-39, 44-47, and 54-67 are pending.

### ***Drawings***

1. The drawings were received on 7/3/07. These drawings are acceptable.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 13-17 and 59-67 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite an eyepiece or body having a transparent peripheral annular peripheral wall. Applicant's specification (pg.6, lines 10-14) recite that the eyepieces are constructed from a relatively stiff and hard transparent plastic. However, the specification does not disclose that the

peripheral wall is transparent. Originally filed claim 49 recites goggles with two annular transparent side walls.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13-17, 54-59, 62, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banks (U.S. 6,131,208) in view of Yashiro (U.S. 5,515,551). Banks discloses the invention substantially as claimed. Banks teaches swim goggles comprising a pair of unconnected eyepieces, each eyepiece comprising a transparent lens 3, frame or body portion 1 surrounding the lens and having a posterior surface, and peripheral flange 5 surrounding the lens portion and peripheral wall. The flange is sized and shaped to fit at least partially within a respective orbital rim and the lens portion positioned in front of an eye when the eyepiece is worn. The flange also includes an upper nasal portion and a lower nasal portion on an inner side that fit within a respective orbital rim and also includes a lower temporal portion on an opposing side that fits at least partially within a respective orbital rim. Each eyepiece is adapted to provide a water-tight seal around an eye of a user during use of the goggles, wherein each eyepiece has a minimum depth about 5.75 mm or less, or of less than 8 mm measured at locations above and below the eyes when the eyepieces are in an as worn

orientation. The recitation of "a minimum depth of less than 8 mm measured at locations...in an as worn orientation" is functional in that it does not recite the structural dimensions of any specific portion of the eyepiece. It is noted that pages 10-11 of Applicant's specification discuss the depth of the eyepieces as measured from the inner surface of the anterior lens and the temporal end of the anterior lens. As currently presented, claim 13 conveys that the depth of the eyepiece is determined by the dimensions of the wearer's eye as well as by the positioning of the eyepiece in relation to the wearer's eye portions. For example, if the eye socket or orbital bones are deeper-set, then the depth of the eyepiece will likely be smaller when measured at locations above and below the eyes. Banks is silent with regard to the depth of the frame portion, but the domed shape of the frame fits over a wearer's eye and appears to have a minimum depth of 5.75 mm or less. The domed shape allows for covering the eyes without interfering with the wearer's eye blinking capabilities. Each eyepiece includes a layer of adhesive tape 5 for adhesively securing the eyepiece to the skin. Each layer of tape comprises a deformable layer that is secured to the posterior surface 4 of a respective frame and has an adhesive surface for adhering to the skin. The eyepieces can be retained in place by contracting the orbicularis oculi muscles against the frame portions. However, Banks doesn't teach a transparent annular peripheral wall surrounding the lens portion. Yashiro teaches swimming goggles with transparent lens portions 6 and transparent annular peripheral walls 2 surrounding the lens portions. The transparent wall allows for the wearer to see peripherally when the head is turned downwardly. Therefore, it would have been obvious to provide Banks with the

transparent wall of Yashiro in order to allow for improved field of vision while the wearer's head is turned in a given direction.

6. Claims 33-35, 37, 38, 44-47, and 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen-Lieh (U.S. 6,341,863). Chien-Lieh discloses the invention substantially as claimed. Chen-Lieh teaches an eyepiece for swim goggles comprising a body 40 adapted to be worn over the eye of a user and form a water-tight seal around the eye that isolates the eye from the surrounding environment during use, the body comprising a transparent lens portion that includes a first, flat anterior lens 21 positioned in front of the eye in an as worn orientation and at least a second, flat lens 22 comprising flat and parallel opposed surfaces. The second lens is connected to the anterior lens at an obtuse angle and extending rearwardly therefrom, wherein the second lens reduces prismatic distortion of the lens portion and is connected to the anterior lens at an angle of less than 180 degrees as shown in Figure 3, which illustrates the obtuse angular relationship. Each eyepiece comprises an annular side wall 11 surrounding a respective anterior lens and side lens and extending rearwardly therefrom. A posterior transparent frame portion 30,31 is connected to a respective side wall opposite the anterior lens and side lens, the frame portion being shaped to form a water-tight seal around an eye. The goggles include a nose piece (not labeled but shown in Figure 1) connecting adjacent nasal end portions of the eyepieces as shown in Figure 5 and a head strap (not labeled) connected to respective temporal end portions of the eyepieces and dimensioned to extend around the rear of the user's head. However, Chen-Lieh doesn't teach the angle is approximately 124 to 164

degrees or about 144 degrees. Chen-Lieh teaches that the angle of less than 180 degrees allows for improved field of vision between the flat lens in front of the eye, and the side lenses. Applicant's specification does not provide the criticality for the obtuse angle in the claimed range. Thus, a preferred range for the angle between the first and second lenses could have been arrived at through routine experimentation. Therefore, it would have been obvious to provide Chen-Lieh's first and second lenses with an angle therebetween of approximately 124 to 164, or 144 degrees such that an optimal field of view and clear vision is achieved and maintained. Since the modified lens orientation of Chen-Lieh discloses the claimed structure, the resulting lens is expected to perform in the same way as recited by claim 37, which states that the second lens reduces hydrodynamic drag of the eyepiece and prismatic distortion of the lens portion such that whenever the eye is rotated temporally to a position at which the visual axis intersects a midpoint of the side lens, a line of sight extends perpendicularly with respect to the side lens. Further, the side lens is oriented with respect to the anterior lens such that a line of sight along the visual axis intersects the side lens at 90 degrees whenever the eye is rotated to a temporal position at which the visual axis intersects the side lens and the line of sight extends through a midpoint of the side lens. Regarding claims 33-35, 37, 44, 45, Chen-Lieh teaches an alternate embodiment in Figure 5 with separate lenses for each eye such that the Chen-Lieh doesn't teach an eyepiece for swim goggles comprising a body adapted to be worn over only one eye of a user, wherein each body includes first and second flat lenses and a frame portion surrounding the lenses. It is known in the art to provide individual eyepieces dimensioned such that

each eyepiece is worn over only one eye of a user. This configuration allows for independent adjustment of each eyepiece over the respective eye area. Therefore, it would have been obvious to modify Chien-Lieh to provide eyepieces having a body adapted to be worn over only one eye of a user and form a water-tight seal around the eye in the event that if one of the eyepieces fails, the wearer's vision is still preserved through the provision of a second individual eyepiece.

#### ***Allowable Subject Matter***

7. Claims 18, 19, 36 and 39 are allowed.
8. Claim 60, 61, and 67 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

9. Applicant's amendment necessitated the revised prior art rejections outlined above. Applicant's remarks are drawn to the deficiencies of the prior art in regard to the claims as currently amended.

#### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP



§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications should be directed to Primary Examiner Katherine Moran at (571) 272-4990. The examiner can be reached on Monday-Thursday from 8:30 am to 6:00 pm, and alternating Fridays.

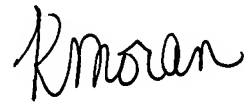
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch, may be reached at (571) 272-4996. The official and after final fax number for the organization where this application is assigned is (571) 273-8300. General information regarding this application may be obtained by contacting the Group Receptionist at (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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October 15, 2007

A handwritten signature in black ink, appearing to read "K Moran". The signature is fluid and cursive, with the first letter "K" being large and stylized.

Katherine Moran

Primary Examiner, AU 3765